REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 30, 2004. In order to advance prosecution of this Application, Claims 2 and 12 have been amended. Applicant respectfully requests reconsideration and favorable action in this Application.

The disclosure stands objected to under 37 C.F.R. §1.58(a) for containing illustrations. The specification has been amended to remove the illustrations at pages 79-80 identified by the Examiner.

Claims 2-12 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants respectfully traverse these rejections for the reasons stated below.

The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." *See* 35 U.S.C. §101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. §101. *See In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q. 2d 1545, 1557 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. §101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. §101. *See AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles

regarding 35 U.S.C. §101 and announced more expansive principles formulated with computer technology in mind); *see also In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

"Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. §101." M.P.E.P. §2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. *See In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. As stated by the Federal Circuit in *State Street* and as explicitly confirmed in the M.P.E.P., "[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete, and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02; M.P.E.P. §2106.

Applicants respectfully submit that Claims 2-12 produce useful, concrete, and tangible results. Claims 2-12 are directed to a method for determining the information technology requirements for a business and how those requirements fit into the overall architecture of the business, thus determining information technology requirements

is one practical and useful application of Claims 2-12. Further, these claims do not concern abstract ideas, but rather concrete and tangible acts such as generating an overall architecture for a business and defining how the manageable entities relate to each other therein, generating a graphical representation of the overall architecture for the business, and generation of a plan for implementation and deployment of information technology among the manageable entities of the business for display in the graphical representation.

In addition, Applicants respectfully submit that insufficient support has been given for the Office Action's rejection of Claims 2-12. "Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result." M.P.E.P. §2106(II)(A). The M.P.E.P. states that "when [a 35 U.S.C. § 101] rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." M.P.E.P. § 2106(II)(A). The Examiner recites selected phrases from Claims 2-12 and labels them "abstract idea[s]" and lacking "sufficient computer structure," but the Examiner does not specifically address the language of the claims and state the interpretation of this language. Thus, the Examiner has not carry the burden of establishing a *prima facie* case for a 35 U.S.C. §101 rejection.

The Examiner cites the proposition that computer structure is required for a patentable invention. Applicant can find no statement in 35 U.S.C. §101 or any other case interpreting 35 U.S.C. § 101 that requires computer structure for a method claim to be patentable. As stated above, a

patentable method claim allows for certain steps to be humanly performed. Moreover, through a graphical representation, the claimed invention provides an implementation in a physical manner. Therefore, Applicant respectfully submits that Claims 2-12 are in accordance with 35 U.S.C. §101.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 2-12.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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